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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/082,692

02/22/2002

Michael K. Zyskowski

MICR0261

5312

27792

7590

09/01/2006

RONALD M. ANDERSON  
MICROSOFT CORPORATION  
600 108TH AVENUE N.E., SUITE 507  
BELLEVUE, WA 98004

EXAMINER

SHARON, AYAL I

ART UNIT

PAPER NUMBER

2123

DATE MAILED: 09/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/082,692	<b>Applicant(s)</b> ZYSKOWSKI, MICHAEL K.	
	<b>Examiner</b> Ayal I. Sharon	<b>Art Unit</b> 2123	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/22/02 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Introduction*

1. Claims 1-34 of U.S. Application 10/082,692, originally filed on 02/22/2002, are currently pending.
2. New 35 U.S.C. § 101 rejections have been added.
3. New on-sale bar rejections have been added as a result of Applicant's submission of references accompanying the Declaration submitted on 6/27/2006.
4. Because the Enclosures to the Declaration were not disclosed in an IDS, the Examiner is adding them in a PTO-892 form.
5. This action is non-final.

### ***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. **Claims 1-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**
8. The fundamental test for patent eligibility is to determine whether the claimed invention produces a **“useful, concrete and tangible result.”** See State Street Bank & Trust Co. v. Signature Financial Group Inc., 149 F. 3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998) and AT&T Corp. v. Excel Communications, Inc., 172 F.3d

1352, 50 USPQ2d 1447 (Fed. Cir. 1999). In these decisions, the court found that the claimed invention as a whole must accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.”

9. See State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. (“[T]he transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces ‘a useful, concrete and tangible result’ – a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades”).
10. See also AT&T, 172 F.3d at 1358, 50 USPQ2d at 1452 (Claims drawn to a long-distance telephone billing process containing mathematical algorithms were held patentable subject matter because the process used the algorithm to produce a useful, concrete, tangible result - a primary inter-exchange carrier (“PIC”) indicator - without preempting other uses of the mathematical principle).
11. The Examiner respectfully submits that the claimed invention does not recite a concrete, useful, tangible result.
12. First of all, the claimed invention does not necessarily produce a result. All of the independent claims (Claims 1, 12, 19, and 29), and their dependent claims, merely “enable” the user to evaluate the result. The user does not necessarily have to do so.

13. The independent claims also recite “enabling the user to input” parameters or data. Again, the user does not necessarily have to do so, therefore the claimed invention does not necessarily produce a result.
14. Moreover, the result of the “user evaluation” takes place in the mind of the user, and not in the claimed invention.
15. In addition, independent claims 1 and 12, and their dependent claims, are directed to functional descriptive material *per se*.
16. “Descriptive material” is nonstatutory when claimed as descriptive material *per se*. In re Warmerdam, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare In re Lowry, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory).

***Claim Rejections - 35 USC § 102***

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18. The prior art used for these rejections is as follows:

19. Applicant's Declaration dated 6/20/2006, and filed on 6/27/2006 ("**Declaration**"), which discusses the following Microsoft products and documents:

a) Microsoft Flight Simulator 2000 (FS2000). As described in the Declaration,

"**Enclosure B**" is the document titled "Microsoft Flight Simulator 2000 Software Development Kit, Aircraft Container System."

b) Microsoft Combat Flight Simulator 2.0 (CFS 2). As described in the

Declaration, "**Enclosure C**" is the document titled "Setting and Changing Aircraft Parameters" of Microsoft Combat Flight Simulator 2.0 (CFS 2).

Moreover, as described in the Declaration, "**Enclosure D**" is the document titled "Importing Aircraft, Missions, and Scenery for Combat Flight Simulator 2".

20. The claim rejections are hereby summarized for Applicant's convenience. The detailed rejections follow.

**21. Claims 1-34 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention.**

22. Both Microsoft Flight Simulator 2000 (FS2000) and Microsoft Combat Flight Simulator 2.0 (CFS 2) contained the features of the claimed invention, according to the Declaration and Enclosures B, C, and D.

23. All of the independent claims recite “enabling a user to create or modify a design” (emphasis added), as well as “enabling the user to input a plurality” of parameters or data.

24. Using the broadest reasonable interpretation of the claims, the user can merely modify a design.

25. In regards to Microsoft Flight Simulator 2000 (FS2000):

a) According to Applicant’s Declaration (see p.3), “FS2000 included the FSEDT application, although the FDE included only one section that allowed certain scalars to be changed by a user positioning a slider.” Examiner finds that this reads on the claimed invention because it provides for modifying a design.

b) Applicant’s Declaration (see p.3) also states that “FS2000 lacked the ability to create flight model data files from scratch ...” Examiner notes that the claims recite “enabling a user to create or modify a design” (emphasis added).

c) Applicant’s Declaration (see p.3) also states that “FS2000 lacked the ability to create flight model data files from scratch that are compatible with the flight simulator as shown in Figure 4 of the above identified application ...”.

Examiner notes that the Applicant is arguing about features that are not in the claims. The limitation of “the flight simulator as shown in Figure 4 of the above identified application” is not recited in the claims.

- d) Applicant's Declaration (see p.3) also states that "... and a user was unable to evaluate this custom design in real-time simulated flight within FS2000, based on a point of view of a pilot flying the aircraft." Examiner interprets that this refers to the inability of FS2000 to create flight model data files "from scratch", and therefore there is no ability to evaluate them. However, the claimed invention does not require evaluating "custom" flight model data files that were created "from scratch".

26. In regards to Microsoft Combat Flight Simulator 2.0 (CFS 2):

- a) According to Applicant's Declaration (see p.3), when discussing CFS 2, states: "As in FS98 and FS2000, Enclosure C explains how a user can import new aircraft and add or change values in the aircraft.cfg file (first paragraph page 1)."
- b) Enclosure C teaches (see first paragraph, page 1): "In Combat Flight Simulator 2, as in Microsoft Flight Simulator 98 and 2000, you can import new aircraft and add or change values in the associated aircraft.cfg file to modify aircraft behavior, performance and damage."
- c) Examiner finds that this reads on the claimed invention because it provides for modifying a design.
- d) Examiner notes that the date of Enclosure C is 11/29/00.

**27. Claims 1-34 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Enclosure C.**



***Response to Arguments***

***Re: Oath/Declaration***

28. Examiner finds applicant's arguments regarding the objection to the Oath/Declaration to be persuasive (see p.9 of Applicant's Remarks filed 6/27/2006). The objection has been withdrawn.

***Re: Claim Rejections - 35 USC § 112***

29. Examiner finds applicant's arguments regarding the 35 USC § 112, 2<sup>nd</sup> paragraph rejections to be persuasive (see pp.9-10 of Applicant's Remarks filed 6/27/2006). The rejections have been withdrawn.

***Re: Claim Rejections - 35 USC § 102***

30. Examiner thanks the Applicant for the detailed response to the on-sale rejections. Examiner has given full faith and credit to Applicant's Declaration, and the accompanying enclosures.

31. The rejections based on the Zyskowski reference have been withdrawn in light of Applicant's disclosure in p.2 of the Declaration filed 6/27/06, that Microsoft Combat Flight Simulator 1.0 "did not provide any editing program or any way for a user to design an aircraft and test fly the user's design with MCFS1.0."

***Conclusion***

32. The following prior art, made of record and not relied upon, is considered pertinent to applicant's disclosure.

33. U.S. Patent 6,553,333 to Shenk. (The reference teaches processing a plurality of user parameters to generate a report of aerodynamic coefficients, but does not produce simulated flying of the aircraft based on a point of view of a pilot flying the aircraft.)

***Correspondence Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ayal I. Sharon whose telephone number is (571) 272-3714. The examiner can normally be reached on Monday through Thursday, and the first Friday of a bi-week, 8:30 am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Rodriguez can be reached at (571) 272-3753.

Any response to this office action should be faxed to (571) 273-8300, or mailed to:

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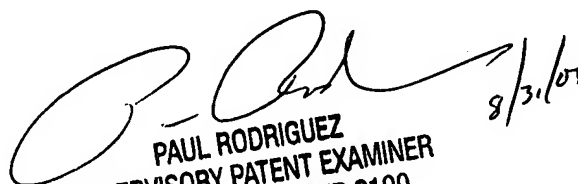
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Art Unit: 2123

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center 2100 Receptionist, whose telephone number is (571) 272-2100.

Ayal I. Sharon  
Art Unit 2123  
August 30, 2006

  
PAUL RODRIGUEZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100  
8/31/06